

### **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of April 14, 2004.

Reexamination and reconsideration are respectfully requested.

### **The Office Action**

**Claims 1, 3-5, and 9-18** stand rejected under 35 U.S.C. §102(b) as being anticipated by Hube et al. (U.S. Patent 5,337,161).

**Claims 6 and 19** stand rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161) in view of Tonomura et al. (U.S. Patent 6,571,054).

**Claims 2 and 20** stand rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161) in view of Tonkin et al. (U.S. Patent 6,616,702).

**Claims 7 and 8** stand rejected under section 103(a) as being unpatentable over Hube et al. (U.S. Patent 5,337,161).

### **The Interview with the Examiner**

On June 14, 2004, Applicants held a telephone interview with the Examiner and the Primary Examiner. Applicants gratefully acknowledge the opportunity to discuss the application and cited references.

At the interview, the Applicants discussed with the Examiners that:

(1) the user interface claimed in claim 1 requires an operator action to enter the tab data;

(2) the merged fields of claim 9 do not constitute the scale and rotation factors of Hube; and

(3) compensating for deleted tabbed pages and automatically accommodating a change in data involving a change in tab modulus (as disclosed in claims 10 and 11) is not inherent in Hube.

It is the Applicants understanding that as a result of the interview, the Examiner will reconsider amended claims 1 and 9 as overcoming the Hube

reference. Regarding claims 10 and 11, it is Applicants understanding that the Examiner will consider Applicants arguments.

### **Claims 1-8 and 10-14 Distinguish Over References**

**Claim 1** calls for among other limitations: an entry of tab data and tab content by the operator. Initially, Applicants submit that Hube does not call for the operator interactively entering the tab data and tab content. Hube discloses a printing system that extracts a tab image from a print job. The document is initially scanned in. The user can select and extract any tab image for printing on a designated tab extension. (Column 8, lines 47-48.) To do so, the tab extraction parameters and transformation parameters such as input orientation, scaling, and the like are determined. Hube does not disclose or suggest entering the contents of the tab. To the contrary, claim 1 calls for an interactive human interface where the operator can enter tab content. Further, Hube discloses that the user selects a tab type from a menu. (Column 7, lines 14-15.) The user would select fifth-cut letter or third-cut letter tab stock. (Column 7, lines 15-16.) Claim 1 calls for an operator to enter a number of unique tab positions.

In addition, claim 1 was amended to call for a tab data entry frame and a page preview frame to be simultaneously displayed on the same screen. It is alleged in the Office Action that Hube discloses a page preview frame showing a tab layout of the unique tab positions for formatted tabbed pages and the tab content for each associated tab in Figure 17, column 8, lines 50-54. Initially, Applicants respectfully traverse Examiner's interpretation of Hube. In column 8, starting at line 50, Hube discloses that a tab image from any page in the print job can be selected and positioned for printing on any designated tab extension. Figure 17 is a mere illustration of the concept and not a display screen. Nowhere does Hube disclose or suggest displaying a page preview frame on the same screen as a tab data entry frame.

It is therefore respectfully submitted that **claim 1** and dependent **claims 2-8 and 10-14** distinguish patentably and unobviously over Hube.

Turning now to **claim 4**, in addition to its relationship to claim 1, claim 4 calls for a page preview frame that shows an accurate contemporaneous image of the tabbed page with the tab content. Nowhere does Hube disclose or suggest a contemporaneous display of a layout of the unique tab positions for the formatted tabbed pages as the information being entered or edited by a user. It is therefore respectfully submitted that **claim 4** distinguishes patentably and unobviously over Hube.

Turning to **claim 11**, in addition to its relationship to claim 1, claim 11 calls for a user interface that is adapted to automatically accommodate a change in tab data involving a change in tab modulus. It is alleged in the Office Action that accommodating a change in tab data involving a change in tab modulus is inherent in Hube by reference to col. 10, line 65 – col. 11, line 36. Applicants respectfully traverse this ground for rejection of claim 11. Applicants reviewed Hube at col. 10, line 65 – col. 11, line 36 and did not locate express or inherent disclosure of the limitation of claim 11. To accommodate a change in tab modulus, the document of Hube needs to be rescanned. This is not an automatic accommodation of the change as claimed in claim 11. Nowhere does Hube disclose or suggest, expressly or inherently, a technique for automatic accommodation of a change in tab data involving a change in tab modulus. It is therefore respectfully requested that this ground for rejection of **claim 11** be withdrawn.

#### **Claim 9 Distinguishes Over References**

**Claim 9** was written in an independent form by incorporating the limitations of independent claim 1. Claim 9 calls for among other limitations: the tab contents that includes preselected merged fields. It is alleged in the Office Action that Hube teaches the tab content including merged fields (a scale factor and a rotation factor), column 10, lines 32-49. The Applicants respectfully traverse Examiner's interpretation of scale factor and rotation factor as merged fields. According to the concepts of the present application, merged fields 150 include a listing of merged items 152 available for insertion within the tab text data entry field 120 (Fig. 1). Nowhere does Hube disclose or suggest using such merged fields. It is therefore

respectfully submitted that **claim 9** distinguishes patentably and unobviously over Hube.

#### **Claims 17-19 Distinguish Over References**

**Claim 17** was amended to follow claim 1. Claim 17 calls for among other limitations: entering by an operator tab modulus data including a number of unique tab positions. Hube discloses that the user selects a tab type from a menu. The user would select fifth cut letter or third cut letter tab stock. (Column 7, lines 13-16.) Nowhere does Hube disclose or suggest that the user enters a unique number of tab positions using an interactive user interface screen. It is therefore respectfully submitted that **claim 17** and dependent **claims 18-19** distinguish patentably and unobviously over Hube.

#### **Claim 20 Distinguishes Over References**

**Claim 20** was amended to follow claim 1. Claim 20 calls for among other limitations: entering tab modulus by an operator and creating by the operator a list of tab contents including at least one of a text and graphics to be printed on each tab. Hube discloses a printing system that extracts a tab image from a print job. The document is initially scanned in. The user can select and extract any tab image for printing on a designated tab extension. (Column 8, lines 47-48.) To do so, the tab extraction parameters and transformation parameters such as input orientation, scaling, and the like are determined. Hube does not disclose or suggest entering the contents of the tab. To the contrary, claim 20 calls for an interactive human interface where the operator can create a list of tab contents. In addition, Hube discloses that the user selects a tab type from a menu. (Column 7, lines 14-15.) The user would select fifth-cut letter or third-cut letter tab stock. (Column 7, lines 15-16.) Claim 20 calls for an operator to enter a number of unique tab positions. Neither Hube, nor Tonkin, taken singularly or in combination, discloses or suggests an interactive operator interface which allows the operator to enter the tab modulus and tab content. It is therefore respectfully submitted that **claim 20** distinguishes patentably and unobviously over Hube and Tonkin.

### CONCLUSION


For the reasons detailed above, it is respectfully submitted all claims remaining in the application (**Claims 1-14 and 17-20**) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment B. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Marina Zalevsky, at Telephone Number (216) 861-5582.

Respectfully submitted,

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